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Supreme Court of the United States

October Term, 1958

No. 246

ALLEN-BRADLEY COMPANY,

Petitioner,

vs.

SQUARE D COMPANY,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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MAY IT PLEASE THE COURT:

This is an ordinary patent infringement case in which the courts below have concurrently *invalidated* petitioner's patent (Wilms and Peterson, No. 2,071,149).

There is no conflict between Circuit Courts of Appeals regarding the validity, scope or infringement of the patent. No basic issue of public importance is raised by the petition and no novel principle of patent law is involved. While it is claimed that there is inconsistency and confusion in the decisions of the Court of Appeals for the Seventh Circuit—a contention which we shall show to be entirely unfounded—a reading of the opinion of that court in the instant case[1] reveals that the conclusion of invalidity is

1. 168 F. 2d 334; R. 2553-2567.

in harmony, and not in conflict, with applicable decisions of this Court. It is manifest that in these circumstances, the petition ought to be denied. Cf. *Keller et al.* v. *Adams-Campbell Co.*, 264 U. S. 314, 319; *Layne & Bowler Corp.* v. *Western Well Works*, 261 U. S. 387, 393.

The petition and supporting brief proceed on the premise —contrary to the facts found by the courts below—that petitioner's patent discloses a new combination having a novel principle and producing a new result; also, they omit essential facts necessary to an understanding of the matter involved. Accordingly, the basic facts will be restated and we shall then show that the reasons relied upon for allowance of the writ are wholly devoid of merit.

Restatement of the Matter Involved.

1. Petitioner's patent (R. 2481) discloses an electric switch of the vertical or straight line type having a hood formed of insulating material completely enclosing the contacts of the switch except for a single opening in the bottom wall through which passes the actuator for the movable contact. The hood is composed of *three readily separable sections* to facilitate access to the contacts for inspection and repair. (Finding of Fact No. 5, R. 101.)

2. The patented switch is of the double break contact type and includes spaced-apart stationary contacts adapted to be bridged by the movable contact when the switch is closed, the contacts being formed of a silver cadmium alloy which has a deionizing effect on the arcs. (*Ibid.*)

3. The actuator for the movable contact is disposed below and outside of the hood, and the contact holder which passes through the single opening substantially closes the opening, it being only sufficiently large to permit the contact holder to slide easily through it. (*Ibid.*)

4. The switch contacts and the conductors leading thereto are so arranged as to form a magnetic loop to spread the arcs apart from each other. (*Ibid.*)

5. Respondent's first switch was placed on the market in July, 1936. It is not true, as stated by petitioner (pp. 9, 13), that this construction was a slavish copy of or like the sectionalized hood of the patent in suit. As was found by the trial court, respondent's device was not covered by the application for patent as it then stood (Finding of Fact No. 13, R. 103). None of the accused devices uses silver cadmium contacts (Finding of Fact No. 35, R. 106); none operates to effect rapid venting of deleterious gases through the clearance about the contact actuator after extinguishment of the arc (Finding of Fact No. 36, R. 106) as is taught in the patent in suit; and all, save the small size switches, have magnetic yokes within the hoods to assist in spreading the arcs and cooling the arc gases (Finding of Fact No. 38, R. 106-7), a device not taught or suggested in the patent in suit.

6. Until the advent of respondent's first switch in July, 1936, the patentees were asserting in the Patent Office that their patentable improvement resided in their particular sectionalized hood which permitted ready accessibility of the contacts for inspection and repair (R. 1685). Thereafter in October, 1936, the application of the patent in suit was amended to introduce new matter which found no support in the original application and which served as the basis for new claims, such as No. 21 in suit. These new claims were not restricted to a sectionalized hood, but called broadly for an enclosing hood for the contacts and a single opening leading thereinto, *i.e.*, a clearance about the contact actuator, through which, according to the new matter, rapid venting of the gases after extinction of the arcs was effective. This was asserted to be a new

principle of operation and it was on this theory that patentability was predicated.[2]

7. Upon the trial, the principle of operation upon which allowance of the claims had been secured was abandoned and petitioner's expert advanced a directly contrary theory which the District Court found, however, not to be established by the testimony (R. 59, 60).[3] On final argument in the District Court, still another theory, also contradicting the statements made to the Patent Office, was presented, but this theory was likewise found not to be supported by credible evidence (R. 60).[4] In the Court of Appeals it was claimed that the patentable improvement is for a new combination of a closed hood around each pair of contacts and a U magnetic loop to impound the arcs into the ends of the closed hood, thereby resulting in increased interrupting capacity, confinement of the arcs until extinction and prevention of flashover.

8. Wilms, one of the patentees, testified, however, that the "problem of arc interruption was solved" when the silver cadmium contacts were first employed (R. 205). This improvement is not embraced in the patent in suit; it is, rather, the subject of another patent owned by petitioner, *i.e.*, No. 1,940,961 (R. 2402).

9. The patentees also admitted during the prosecution of the application for the patent in suit that complete enclosure of the contacts was known in the art and was dictated by past experience (R. 1683-5).[5] Quite apart from this admission which had been necessitated by the citation of the prior patents to Thomson (R. 2203) and Ancotti *et al.* (R. 2195), the District Court found that

2. See Findings of Fact Nos. 14, 15, 16 & 17, R. 103-4.
3. See Findings of Fact Nos. 19, 20, 21, R. 103.
4. See Finding of Fact No. 22, R. 104-5.
5. See also Finding of Fact No. 9, R. 102.

complete enclosure of contacts was old and well known as evidenced by at least eight other patents (Finding of Fact No. 10, R. 102).

10. Moreover, the use made in the switch of the patent in suit of a U-shaped loop in conjunction with a double contact arrangement which tends to cause the two arc columns to spread from each other is the same as that disclosed in the prior art Wilms & Dawe patent No. 1,981,534 (R. 2148). It is this action which drives the arc gases against the side walls of the hood and sets up a turbulence in the chamber which increases the rate of deionization of the hot gases and tends to interrupt the arc at the point of current zero (Finding of Fact No. 24, R. 105). Cooling is also obtained by impounding the arcs, this effect being dependent upon the spacing of the walls from the contacts, the area of the walls and the material from which the hood is made (Finding of Fact No. 25, R. 105). The cooling effect of a hood was appreciated and taught not only by the prior Wilms and Dawe patent No. 1,981,534, but also by the prior patents to Wilms and Loock No. 1,804,729 and Wilms No. 1,901,573 (Finding of Fact No. 26, R. 105).

11. The District Court found that the enclosed hood of the patent in suit does not involve invention over the prior art Wilms and Dawe patent. In its painstaking opinion the District Court found that adding a bottom wall to the Wilms and Dawe switch, to completely enclose the contacts except for a single opening in the bottom wall through which the actuator passes, "is a mere mechanical device permitting the moving of the movable contacts" into and out of engagement with the fixed contacts (R. 62-3). The District Court also found the patent in suit invalid because (a) its description is "too indefinite" and not a

compliance with the provisions of 35 U. S. C. § 33[6], and (b) new matter had been improperly added, after the advent of respondent's device (R. 63-4).

12. Affirming the District Court, the court below found (R. 2564) that there was "nothing novel, either in the principle or the result" of the device disclosed in petitioner's patent and it expressly agreed with the District Court that the "means employed" by the patentees did not rise above mere mechanical skill (R. 2562). In view of its concurrence in the District Court's conclusion that patentable invention had not been shown, the court below considered it unnecessary to pass upon the other grounds utilized by the trial court for the judgment invalidating the patent (R. 2565).

6. As pointed out by the District Court, the chameleon-like character of the description is such that plaintiff "could claim at one time a complete enclosure, at another an opening permitting rapid venting of the gases and at another a throttling which would prevent rapid but permit slow escape of the gases." (R. 63.)

ARGUMENT.

I.

There Is No Confusion in the Seventh Circuit Regarding the Standard of Invention.

The chief trouble with petitioner's first point is that petitioner erroneously assumes that in *National Slug Rejectors, Inc.* v. *A. B. T. Mfg. Corp.*, 164 F. 2d 333, a *modicum of utility* and a *modicum of novelty* were regarded by the Seventh Circuit Court of Appeals as a sufficient standard of invention complying with the requirements of the patent statutes (35 U. S. C. § 31).

Of course, the court below did not fix any such standard in the *National* case; to have done so would have constituted a departure from *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, where this Court held that *utility* and *novelty* do not necessarily make a device patentable and that under the statute a device "must not only be 'new and useful,' it must also be an 'invention' or 'discovery'."

Thus it will be found upon reading the opinion in the *National* case, that following the limited language quoted by petitioner, the court expressly stated (164 F. 2d 335) that a certain "kind or quality of the novelty" must be present and that the courts have long, if not always, required—

> "* * * that there be something in the originality,—something about the novelty, which makes the 'new' in the mechanism something to cause the court to say 'here an inventor labored.'
>
> "This century-old question is always perplexing. We can not avoid or evade it. We must meet it."

The patent in the *National* case was sustained, not only because the device was *new* and *useful*, but because in view of the prior art and the other facts in the case, the court was persuaded that the first prerequisite of patentability, *i. e.*, inventiveness, was also present.

Nor is there any inconsistency between the standard of invention adopted in the case at bar and that applied in *Iron Fireman Mfg. Co.* v. *Industrial Engineering Corp.*, 89 F. 2d 904. Validity was not upheld in that case simply because of novelty and utility; it appears, rather, that the court expressly considered inventiveness and rejected (p. 909) the contention that the improvement was nothing more than that which any electrician would adopt in the exercise of mechanical skill.

Finally, it should be noted that petitioner's assertion (p. 13) of a conflict with the Fourth Circuit decision in *Lever Bros. Co.* v. *Procter & Gamble Mfg. Co.*, 139 F. 2d 633, is both unwarranted and unsound. In the first place, the court below, contrary to petitioner's assumption, did not deny invention "because of want of utility," and, secondly, it is a meaningless quibble to complain about respondent's alleged estoppel to deny utility when the decisions below rest on the fact finding that the exercise of the inventive faculty is shown by the evidence to be wanting.

II.

The Court of Appeals Has Not Departed From the Principles of Patent Law Announced in Decisions of This Court.

The settlement of the question raised by petitioner's second point is of importance only to petitioner for it does no more than advance petitioner's case on alleged patentable invention which both of the courts below refused to

adopt. Indeed, petitioner is really seeking a retrial in this Court of this issue, and would have this Court overturn concurrent findings and redetermine the fact question of whether the improvement required mere mechanical skill or the exercise of the faculty of invention. This Court, under a settled rule, has repeatedly held that it will not disturb concurrent findings on questions of fact unless they are clearly erroneous. *Goodyear Tire & Rubber Co.* v. *Ray-O-Vac Co.*, 321 U. S. 275, 278; *Williams Manufacturing Co.* v. *United Shoe Machinery Corp.*, 316 U. S. 364, 367; *Thompson Spot Welder Co.* v. *Ford Motor Co.*, 265 U. S. 445, 446, 447; *Adamson* v. *Gilliland*, 242 U. S. 350, 353; *Battin* v. *Taggert*, 17 How. 74, 85.

Petitioner does not succeed in showing the findings of the court below to be "clearly erroneous" simply by assuming that the principle of the switch of the patent in suit is new and by misstating the grounds of the Court of Appeals' conclusion of invalidity. The appraisal by the court below of the "new" combination as consisting of two elements was one of limitation gleaned from petitioner's brief (R. 2558-9). After noting that petitioner did not attack the trial court's finding that each element was old and well known,[7] the court below made its own examination of the prior patents and pointed out (R. 2561) that it was not "open to dispute" that the "magnetic loop feature as well as the enclosed hood were old." The court below said that even when it was assumed that the arcs are more securely impounded and more rapidly extinguished in an enclosed hood, *i. e.*, that a better result is obtained, it was nevertheless compelled to agree with the trial court that the "means employed" was not of "such an ingenious nature as to amount to invention." The court went on,

7. Thus the Court said (R. 2559): "The court below, as already noted, found that both of the elements relied upon were old and well known and, so far as we are aware, plaintiff makes no attack upon such finding."

moreover, to review the proceedings in the Patent Office and the admissions of the patentees that past experience had dictated complete enclosure and concluded (R. 2564) that under a "most generous appraisal" of the claimed invention there was "nothing novel, either in the principle or the result."

The decisive answer to petitioner's contention that such cases as *Williams Mfg. Co.* v. *United Shoe Machinery Corp.*, 316 U. S. 364, and *Eibel Process Co.* v. *Minnesota & Ontario Paper Co.*, 261 U. S. 45, require a reversal of the judgment is that the court below regarded the question of patentable invention *sub judice* to be controlled by, and rested its conclusions primarily upon, such decisions of this Court as *Smith* v. *Nichols*, 88 U. S. 112, 119 (a mere change in degree), *Permutit Co.* v. *Graver Corp.*, 284 U. S. 52, 60 (merely providing a necessary hole in a bottom wall), *Planing-Machine Co.* v. *Keith*, 101 U. S. 479 (merely enlarging proportions and sizes of parts), and *Electric Cable Joint Co.* v. *Brooklyn Edison Co. Inc.*, 292 U. S. 69, 79, 80, and *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477, 486 (mere substitution or other advance plainly indicated by the prior art).

III.

No Basic Conclusions Unsupported by Other Evidence Were Drawn from the Patentee's Writings and Admissions.

Petitioner's third point is without merit because the court below did not invalidate the patent solely because of statements in an article written by the patentee Wilms and his admissions elicited on cross-examination.

Reference was made to the article to show (R. 2562) that the patentee had not recognized in October, 1935, the "novel

features which are now claimed as invention," and his cross-examination was quoted to establish his own appraisal—*superficial* "minor differences"—of the "principles" found in the switch of the patent in suit and that of the prior Wilms and Dawe patent. But no basic conclusions were *per se* rested upon the writings and admissions. This is manifest both from the Court's earlier agreement with the trial court that the exercise of invention had not been shown and from its own earlier independent conclusion, *viz.* (R. 2562):

> "We should think that it would hardly require the skill of a mechanic to appreciate that an element so elusive as an electric arc could be more readily and firmly impounded in a hood enclosed on all sides than in one open at the bottom."

Since a case "made out in all its elements by cross-examination of opposing witnesses is a strong case" (*Eibel Process Co.* v. *Minnesota & Ontario Paper Co.*, 261 U. S. 45, 53), it was of course eminently proper for the Court to indicate in its opinion the confirmation and support, found in the patentee's writings and testimony, of its conclusions which had been reached on other evidence.

Conclusion.

There are not present in this case any of the grounds which the prior decisions of this Court have held were essential to move it to grant a writ of certiorari in a patent infringement case. Moreover, petitioner does not attack either of the additional grounds utilized by the trial court to invalidate the claims in suit. These grounds, *i. e.*, indefiniteness and new matter, or either thereof, adequately support the judgment below. It would seem to be entirely futile in the premises, therefore, to grant a review, for not only has petitioner failed to show clear error in the con-

current findings of no invention, but the result reached below is in any event correct and justified in view of other sound, unassailed reasons.

Accordingly, the petition for a writ of certiorari should be denied.

Respectfully submitted,

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